

**REMARKS**

Claims 1-21 are currently pending in the application. By this amendment, claims 10 and 14 are amended for the Examiner's consideration. The specification and drawings are also amended. No new matter is added. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

***Examiner Interview***

Applicants appreciate the courtesies extended by Examiners Miller and Walsh to Applicants' undersigned representative during a personal examiner interview conducted on July 15, 2003. During this interview, the outstanding §101 and §112 rejections were discussed. It was agreed that an affidavit under 37 C.F.R. §1.132 would be submitted in order to overcome the §101 ands §112, 1<sup>st</sup> paragraph rejections. Attached hereto is a §1.132 affidavit of an expert.

The §1.132 affidavit shows that the disclosure for the above-identified application would enable one of ordinary skill in the art to use and make the invention without undue experimentation, and that the disclosed invention is operative and has utility. The §1.132 affidavit also shows that the claims contain subject matter which was adequately described in the specification in such a way as to reasonably convey to one skilled in the art that he inventor(s), at the time the application was filed, had possession of the claimed invention. The §1.132 affidavit, amongst other issues, addresses the Examiner's concerns about how to use the vacuum conveyor (i.e., feeder head mechanism) and the detection system.

***Drawings***

The drawings are amended to correct minor typographical and drawing errors. In figure 1, a belt 118 is shown. Also, "CCR" is changed to "OCR", as written throughout the specification. In Figures 2 and 3, "OCR" is placed in box 113. Additionally, in Figure 2, arrows are added at the end of lead lines for reference numerals 112 and 118. In Figure 4, a typographical error is corrected to "VACUUM" in box 112. Additionally, the addition of

reference numerals 112a, 112b, 118a and 118b are added to Figure 4 to represent the different vacuum ports and the belts, as recommended by the Examiner.

***Specification***

The specification has been amended, in accordance with the Examiner's recommendation, to include separate reference to two separate vacuum chamber assemblies 112a and 112b. The specification is also amended to include separate reference to the belts 118a and 118b.

***35 U.S.C. §101 and §112, 1<sup>st</sup> Paragraph Rejections***

Claims 1-21 were rejected under 35 U.S.C. §101 and §112, 1<sup>st</sup> paragraph. These rejections are respectfully traversed.

Applicants submit an affidavit under 37 C.F.R. §1.132 of an expert, Mr. Michael Wisniewski. This affidavit shows that the disclosure of the invention, as read in its entirety, would enable one of skill in the art to make and use the claimed invention without undue experimentation. It is also the opinion of Mr. Wisniewski that the specification discloses an invention that is operative and has utility; namely, allowing product to be oriented with edges in a homogenous orientation. Briefly, in this affidavit, Mr. Wisniewski discusses how the disclosure shows (i) how the detection system works and (ii) how the vacuum conveyor "picks up" product without ripping the cover or jamming the machine.

Applicants further submit that according to MPEP §2107, deficiencies under the "useful invention" requirement of 35 U.S.C. 101 will arise in one of two forms. The first is where it is not apparent why the invention is "useful." The second type of deficiency arises in the rare instance where an assertion of specific and substantial utility for the invention made by an applicant is not credible. These are simply not true or applicable in the present matter. The specification clearly shows that the invention is designed to orient product in a homogenous orientation (page 5). This shows usefulness, in of itself.

Additionally, as the Federal Circuit has stated, "[t]o violate [35 U.S.C.] 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced*

*Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992). See also *E.I. du Pont De Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980) (A small degree of utility is sufficient. An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely. In short, the defense of non-utility cannot be sustained without proof of total incapacity.") In the present disclosure, as evidenced further in the accompanying affidavit, the invention would work without jamming the machine or ripping the cover. In fact, even if it were to jam the machine, from time to time or rip a cover, which it does not, there would still be utility and operability, as discussed in the *Brooktree Corp.* or *E.I. du Pont De Nemours and Co.*

Accordingly, Applicants respectfully request that the rejections over claims 1-21 be withdrawn.

***35 U.S.C. §112, 2<sup>nd</sup> Paragraph Rejection***

Claim 1-10, 14, 15 and 17-21 were rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. This rejection is respectfully traversed.

Claims 1-10 were rejected as omitting an essential element, the optical recognition system. Applicants submit that the specification, not once, discloses the optical character recognition system as an essential feature for the invention to work in its intended manner. This statement, or any similar statements, wa not made. What is essential to the invention is the movement of the product from a central compartment to either side compartments. This is performed by the feed head mechanism, as clearly recited in claim 1. The optical character recognition system, albeit novel in combination with other features, may be omitted from claim 1 and the system would still work by using, for example, a known count of the product stacked in a certain orientation.

Claim 10 is amended to delete "type". Claim 14 is amended to depend from claim 13.

As to claim 17, it is submitted that the recitation of "bound" edges is not necessary. As discussed in the accompanying §1.132 affidavit, the system and method of the invention can be used for orientation based on any feature. These features can be on any edge of the product such

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as address or other information. Thus, the use of bound is not required. Typically, though, the system is used for distinguishing bound and non bound edges of the product.

Accordingly, Applicants respectfully request that the rejection over claims 1-10, 14, 15 and 17-21 be withdrawn.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submits that all of the rejections are overcome. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

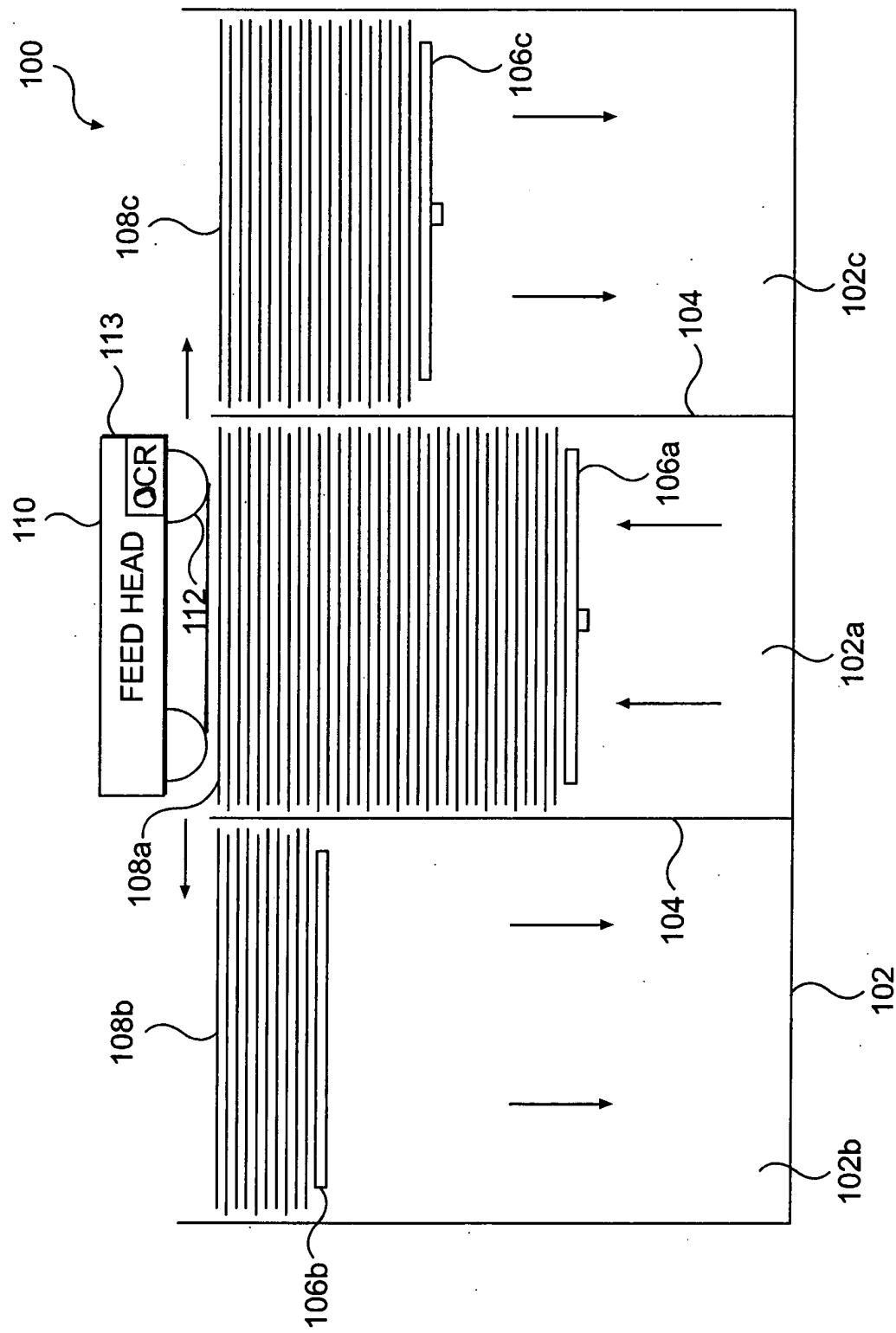
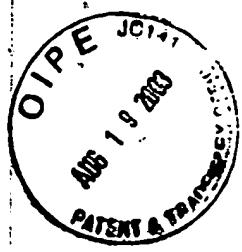
Respectfully submitted,



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Replacement Sheet  
U.S. Serial No. 10/075,596  
7/28/03



**FIG. 1**

Replacement Sheet  
U.S. Serial No. 101075,596  
7/28/03

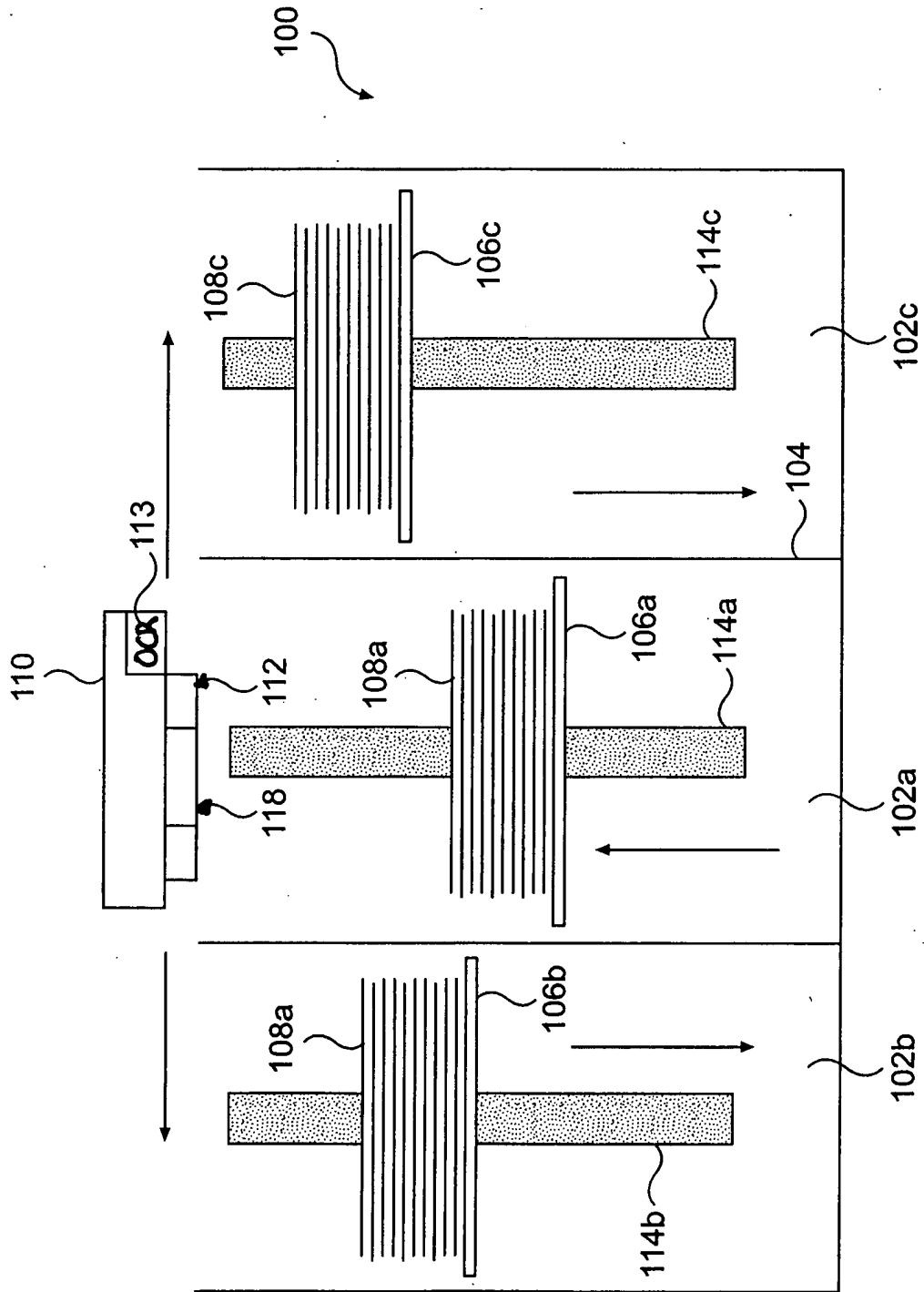
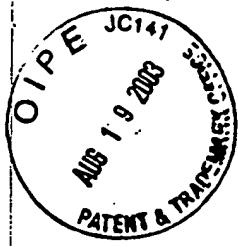
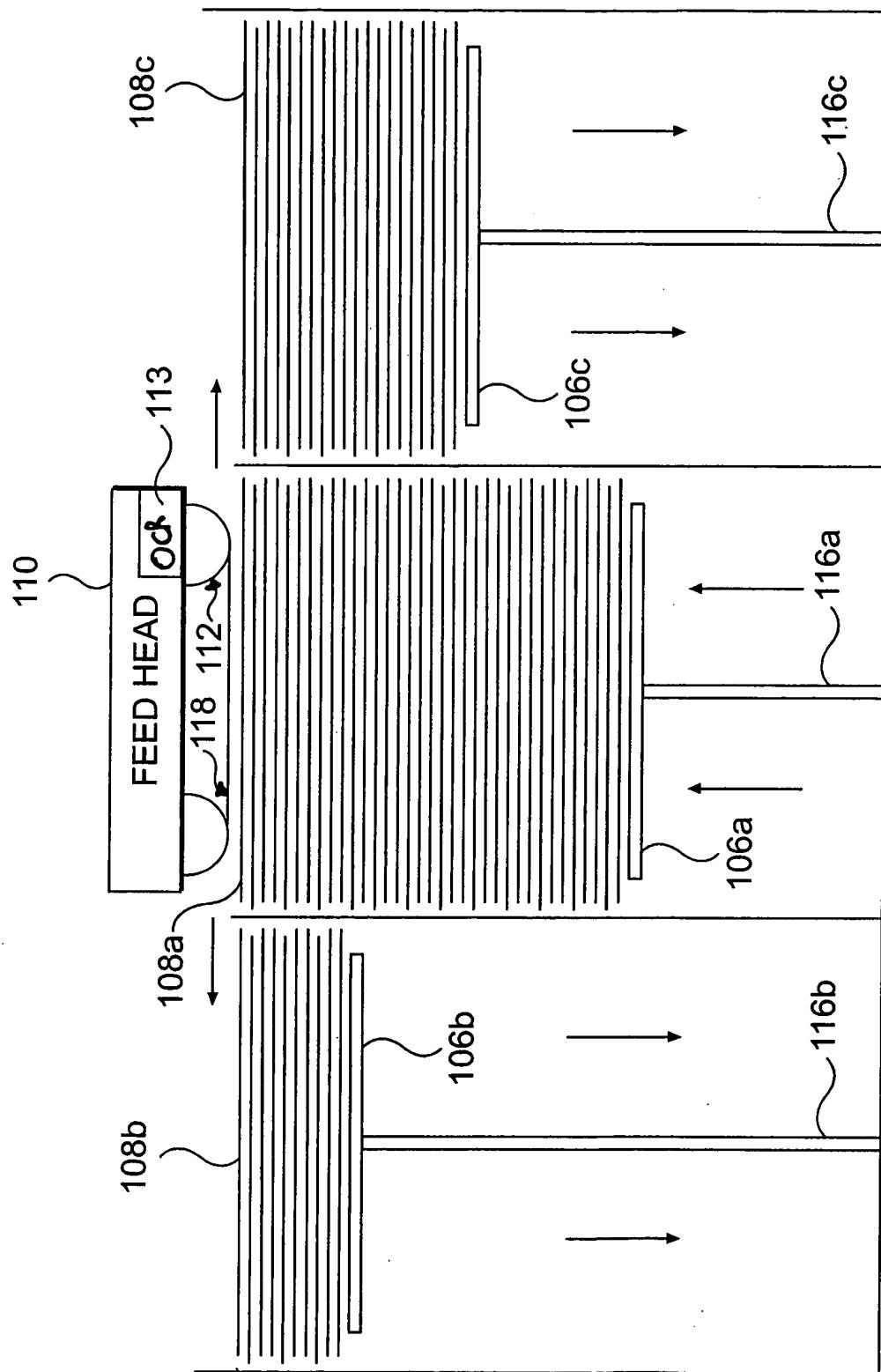
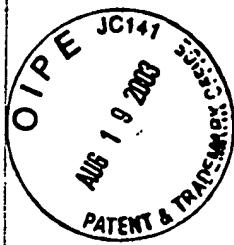


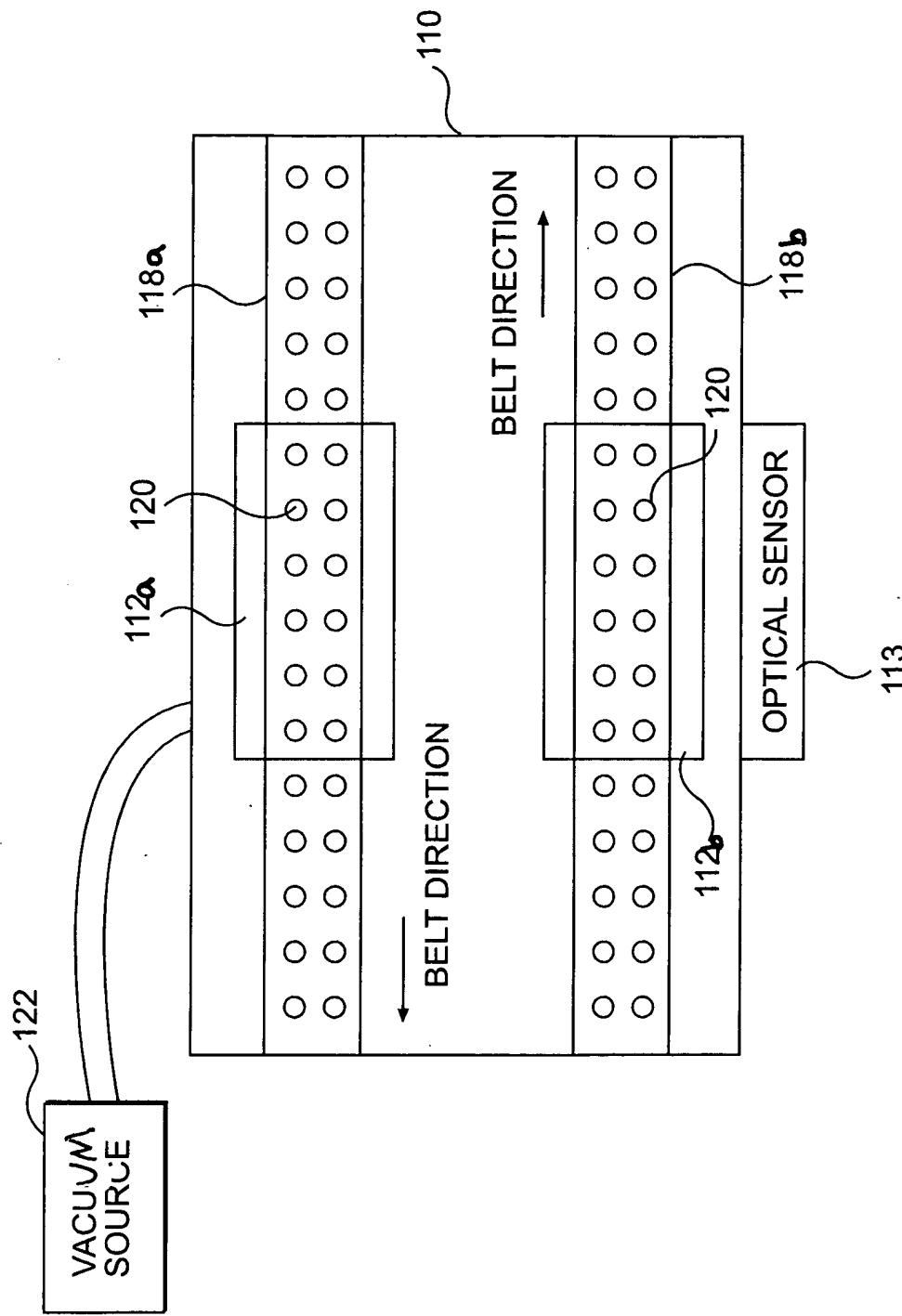
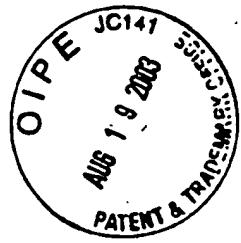
FIG. 2

Replacement Sheet  
U.S. Serial No. 101075, 596  
7/28/03



**FIG. 3**

Refrigerant Sheet  
U.S. Serial No. 10/075,576  
7/28/03



**FIG. 4**